

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Upvan NARANG et al.

Application No.: 09/430,177

Filed: October 29, 1999

For: ADHESIVE APPLICATOR TIP WITH A POLYMERIZATION INITIATOR,
POLYMERIZATION RATE MODIFIER, AND/OR BIOACTIVE MATERIAL



Group Art Unit: 1615

Examiner: T. Ware

Docket No.: 100448.01

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RESPONSE TO RESTRICTION REQUIREMENT

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

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In response to the Restriction Requirement mailed January 3, 2001, restriction was required between Group I (claims 1-25 and 50-61), Group II (claims 26-49 and 62-75), Group III (claims 76-102, 120-124 and 135-143), Group IV (claims 103-119), and Group V (claims 125-134 and 144). In response to the Restriction Requirement, Applicants hereby elect the claims of Group III (claims 76-102, 120-124 and 135-143). This election is made with traverse.

Applicants respectfully submit that the Restriction Requirement is improper, at least as between some of Groups I-V. In particular, Applicants respectfully submit that restriction between Groups I, III, IV and V is improper, and request that the Restriction Requirement be withdrawn.

A. Restriction Between Groups I and III is Improper

In the Restriction Requirement, the Patent Office asserts that restriction between Groups I and III is proper because the process as claimed can be practiced by another materially different apparatus. Applicants respectfully disagree.

Group III is directed to an applicator, and particularly to an applicator for a polymerizable adhesive, comprising an applicator tip attached to an applicator body, and at least one bioactive material or flavorant on or in the applicator tip. See independent claim 76. Claim 1 is directed to a method of applying at least one agent selected from the group consisting of bioactive materials, flavorants, polymerization initiators, and polymerization rate modifiers to an applicator tip for an adhesive applicator. See independent claim 1. The Office Action asserts that the process as claimed can be practiced by another materially different apparatus, particularly wherein the adhesives are applied in monomeric form to the surfaces to be joined. However, this allegation does not support the Restriction Requirement. The allegation fails to show that the process as claimed in claim 1 can be practiced by another materially different apparatus or by hand, or that the apparatus as claimed in Group III can be used to practice another and materially different process from the process of Group I. Rather, in the present case, Group I is directed to a method of applying a material to an applicator tip, whereas Group III is directed to an applicator, comprising an applicator tip having a material on or in the applicator tip. Accordingly, Group I is directed to a method of preparing an applicator tip having a particular material applied thereon or therein, which applicator tip may be suitable for use in the applicator of Group II.

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120-134 Furthermore, claims presently grouped in elected Group III depend directly from claim 25, which is currently grouped in Group I. For example, claim 120 is directed to an applicator for a polymerizable adhesive, comprising a conduit for a fluid polymerizable

adhesive material and an applicator tip according to claim 25. Claim 25, grouped in Group I, is directed to an applicator tip made by the method of claim 1, which is also grouped in Group I. Accordingly, search and examination of the claims of Group III, which includes the limitation of the applicator tip of claim 25 (Group I), will encompass a search for the subject matter of Group I. Accordingly, no additional burden would be placed on the Patent Office to search and examine the claims of Group I, along with the claims of elected Group III.

For at least these reasons, the Patent Office has failed to establish a proper basis for restriction between Groups I and III. Accordingly, reconsideration and withdrawal of the Restriction Requirement between these groups is respectfully requested.

B. Restriction Between Groups III and V is Improper

Applicants also respectfully submit that the Restriction Requirement between Groups III and V is also improper. In particular, Applicants respectfully point out that the Office Action fails to provide any basis for restriction between any of Groups I-IV and Group V. However, regardless of this omission, Group V should be rejoined and examined with at least Group III.

As discussed above, Group III is directed to an applicator. Group V is directed to a kit comprising a saleable package containing a container that contains a polymerizable monomer composition and an applicator according to claim 76. See claim 125. Accordingly, the claims of Group V depend directly or indirectly from the claims of Group III. Applicants thus respectfully submit that search and examination of the claims of Group III will encompass and be commensurate with a search of the subject matter of Group V. Any further search and/or consideration that may be required with respect to the claims of Group V would not place an undue burden on the Patent Office.

Accordingly, the Patent Office has failed to establish any proper basis for restriction between at least Group III and Group V. Accordingly, reconsideration and withdrawal of the Restriction Requirement between Groups III and V are respectfully requested.

C. Group IV Should Be Rejoined With Group III

Group IV is directed to a method of making a medical adhesive composition, utilizing, for example, the applicator defined in Group III. Accordingly, Group IV is directed to a method of use of the applicator of Group III. Applicants thus respectfully request rejoinder of the claims of Group IV with Group III.

Where product and process claims are presented in the same application, Applicants may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.* Since the method claims of Group IV include all the limitations of the product claims of Group III, the process claims must be rejoined with the product claims when the product claims are found to be allowable. In the interest of expediting prosecution, Applicants respectfully request rejoinder of the claims of Groups IV and III so that search and examination of both groups of claims can proceed.

Accordingly, reconsideration and withdrawal of the Restriction Requirement between Groups III and IV is also respectfully requested.

D. Examination of the Entire Application Would Not Place A Burden Upon the Patent Office

For at least all of the reasons described above, the claims of Groups I-V are very interrelated. Search and examination of any one group of claims will thus at least overlap, and in some cases fully encompass, the search for the subject matter of other groups of

claims. Accordingly, in the interest of advancing prosecution and reducing the burdens upon the Patent Office and Applicants', the Restriction Requirement between all of Groups I-V should be withdrawn.

According to MPEP §803, there are two requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . " (emphasis added). Applicants respectfully submit that the Office Action has failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

In the present application, Groups I to V are directed to inter-related subject matter, as evidenced by the inter-dependency of claims in the separate groups. Accordingly, search and examination of the subject matter of any one Group of claims, and particularly of elected Group III would encompass a search for the subject matter of Groups I, II, IV and V, and any additional search would not impose a serious burden upon the Examiner.

It is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). Because Applicants have elected Group III, directed to an applicator, the further search and examination of Groups I, II, IV and V would not place a serious burden upon the Examiner.

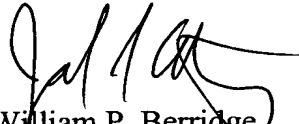
For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

E. Conclusion

For all of the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

Should the Examiner have any questions or comments regarding this communication, the Examiner is requested to telephone Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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WPB:JSA/jam

Date: January 24, 2001

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